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09/774,654	02/01/2001	Noriko Baba	WN-2288	8321

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EXAMINER

CHEN, CHONGSHAN

ART UNIT	PAPER NUMBER
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2172

16

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/774,654

Applicant(s)

BABA, NORIKO

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>15</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 18 February 2004, regarding the reference number is not automatically generated, have been fully considered but they are not persuasive.

Ishimaru teaches an attribute data includes the number of times an item has been search for, and mark the words (Ishimaru, col. 2, lines 31-32, col. 7, lines 1-67). Ishimaru further teaches "other methods, such as enabling selection of another mode whereby a mark it attached automatically when searching for a word, would also be possible ... in automatic mode, processing would occur so as to always add a mark" (Ishimaru, col. 7, lines 53-61). Clearly, the system of Ishimaru has the capability to automatically generating and recording the number of times the respective topic in the past was referred to as a search result.

Also examiner wants to point out a case law, which teaches that an automatic means to replace a manual activity is not sufficient. See *In re Venner*.

*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed."

The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)

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2. Applicant's arguments regarding the references do not teach "priority given to topics having a reference number that is large" have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mead et al (6,493,706). Please see the detailed rejection below.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-10 and 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru (6,427,155) in view of Mead et al. ("Mead", 6,493,706).

As per claim 1, Ishimaru discloses an electronic manual search system comprising:

an electronic manual composed of a plurality of topics (Ishimaru, Fig. 2 & 10, col. 1, lines 61-65, According to the specification, electronic dictionary can be referred to as "electronic manual", part is referred to as "topic", page 2, 2<sup>nd</sup> & 3<sup>rd</sup> paragraph);

a reference number table which stores, for each topic, a reference number expressing how many times the topic has been referred to by a user, wherein the reference number is automatically generated and records the number of times the respective topic in the past was referred to as a search result (Ishimaru, Fig. 2 & 10, col. 7, lines 1-67, col. 9, lines 44-67,

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“provides an electronic dictionary that can inform users of the number of times a search has been performed”);

a search process unit which searches contents of the parts based on a search condition (Ishimaru, Fig. 2);

a search result display unit which displays topics which resulted from the search process unit, in order based on the reference number (Ishimaru, col. 7, lines 64-65, “the words would be displayed on screen, sorted by search frequency in ascending or descending order”).

Ishimaru does not explicitly disclose searching contents in order based on the reference number with priority given to topics having a reference number that is large. Mead teaches searching contents in order based on the reference number with priority given to topics having a reference number that is large (Mead, col. 2, line 30 – col. 3, line 15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to search contents in order based on the reference number with priority given to topics having a reference number that is large in the system of Ishimaru. The reference number indicates the number of times the respective topic was searched. The user is more likely to find desired information in a topic with the largest reference number since that topic is the most popular topic. Therefore, searching the most popular topic first will improve the search efficiency and find desired information faster.

As per claim 3, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach a reference number update unit which increments by one the reference number of a topic when the user selects and/or refers to the topic among topics which are

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displayed by the search result display unit (Ishimaru, Fig. 2, S7, “Increment the Mark Number”, col. 7, lines 1-5, Cole, col. 4, line 61- col. 5, line 7).

As per claim 4, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach a reference number update unit which increments by one the reference number of a topic displayed immediately before the user stops displaying of the search results (Ishimaru, Fig. 2, S7, “Increment the Mark Number”, col. 7, lines 1-5, Cole, col. 4, line 61- col. 5, line 7).

As per claim 5, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach the order of displaying the searched parts is a descending order of the reference number of the topics (Ishimaru, col. 7, lines 64-65).

As per claim 6, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach the order of searching is a descending order of the reference number of the topics (Mead, col. 2, line 30 – col. 3, line 15).

As per claim 7, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach the reference number table is incorporated into the electronic manual (Ishimaru, Fig. 10, col. 7, lines 6-10).

As per claim 8, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach the reference number table stores the reference number for each user class (Ishimaru, Fig. 10).

Claim 9 is rejected on grounds corresponding to the reasons given above for claim 1.

Claim 10 is rejected on grounds corresponding to the reasons given above for claim 1.

Claims 12-13 are rejected on grounds corresponding to the reasons given above for claims 5-6.

Claim 14 is rejected on grounds corresponding to the reasons given above for claim 1.

As per claim 15, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 14, and further teach the reference number is stored for each class of a user who refers to the topic as searched results (Ishimaru, col. 2, lines 31-32).

As per claim 16, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 17, and further teach displaying topics which are obtained by the searching step as search results, in order based on the reference number (Ishimaru, col. 7, lines 64-65).

Claims 17-21 are rejected on grounds corresponding to the reasons given above for claim 1.

As per claim 22, Ishimaru and Mead teach all the claimed subject matters as discussed in claim 1, and further teach a plurality of users can share the electronic manual search system by using the Internet or an in-house LAN (Ishimaru, col. 4, lines 20-21).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chao et al. (6,325,632) teach a search engine performs search from the utmost important category first and goes on down (col. 5, lines 39-41).

Crawford et al. (5,649,221) teach reverse electronic dictionary using synonyms to expand search capabilities.

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is 703-305-8319. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703)305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 16, 2004

  
SHANID ALAM  
PRIMARY EXAMINER